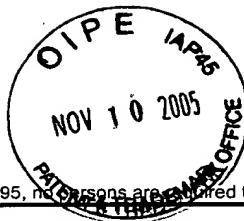


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

KERS3001/JEK/JJC

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Application Number

09/917,947

Filed

July 31, 2001

First Named Inventor

Guido KERSTEN et al.

Art Unit

2193

Examiner

Lawrence J. SCHRADER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☐ attorney or agent of record.
Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 46,205

Signature

JUSTIN J. CASSELL

Typed or printed name

(703) 683-0500

Telephone number

November 10, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Inventor: Guido KERSTEN et al.

Attorney No.: KERS3001/JEK/JJC

Application No.: 09/917,947

Customer No.: 23364

Filed: July 31, 2001

Confirmation No: 1529

Examiner: Lawrence J. SCHRADER **Art Unit:** 2193

For: BANK NOTE PROCESSING MACHINE AND METHOD FOR
OPERATING BANK NOTE PROCESSING MACHINE

ARGUMENTS IN FAVOR OF PRE-APPEAL BRIEF CONFERENCE

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

This paper accompanies the PRE-APPEAL BRIEF REQUEST FOR REVIEW, and includes arguments in support for the pre-appeal brief conference and allowance of the pending claims. These arguments are in response to the Office action dated August 11, 2005, and refer to the remarks accompanying the reply filed on June 22, 2005 in response to the Office action dated March 23, 2005. A Notice of Appeal is submitted herewith with the appropriate fee.

ARGUMENTS

The sole rejection that will be addressed in an appeal brief is the rejection of claims 1, 2 and 4-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,039,645 (Mazur) and U.S. patent 6,766,056 (Huang et al.). This rejection merits review by the pre-appeal brief panel on the basis that the Mazur patent and the Huang et al. patent, whether considered individually or collectively, fail to disclose or suggest the bank note processing machine according to claim 1. Accordingly, claim 1 is patentable in view of the combination of teachings of the Mazur and Huang et al. patents since the combination of these references does not constitute a case of *prima facie* obviousness. Claims 2 and 4-7 are patentable based on their dependency from claim 1 and their individually recited features.

Accordingly, there is clear error in the rejection of claims 1, 2 and 4-7 since essential elements required to establish a *prima facie* rejection are not provided in the current rejection of the claims.

While the outstanding Office action indicates that the applicants' remarks in the reply dated June 22, 2005 are moot in view of the new rejection of the claims, the rejection still consists of the Mazur and the Huang et al. patents, as previously established in the Office action dated March 23, 2005. The applicants consider their remarks in the reply of June 22, 2005 still appropriate, particularly the remarks directed to the fact that one skilled in the art would not be motivated by the teachings of the Mazur and Huang et al. patents to make the bank note processing machine according to claim 1.

The shortcomings of the Mazur patent are detailed on pages 4-7 in the remarks section of the reply of June 22, 2005.

The shortcomings of the Huang et al. patent are detailed on pages 7-9 in the remarks section of the reply of June 22, 2005.

The shortcomings of the proposed combination of the Mazur patent and the Huang et al. patent are provided in substantial detail on pages 9-13 in the remarks of the reply of June 22, 2005. It is asserted that the combination of the Mazur and Huang et al. patents fail to establish a *prima facie* case of obviousness of claim 1. Specifically, the reply states the following grounds and establishes reasons that:

- (1) The combined teachings of the Mazur and Huang et al. patents fail to teach each and every limitation of claim 1;
- (2) there is no motivation among the Mazur and Huang et al. patents, or knowledge readily known to one skilled in the art to combine the teachings of these patents to make the bank note processing machine according to claim 1; and
- (3) even if the Mazur and Huang et al. patents were combined, there is no reasonable expectation that a bank note processing machine would successfully be obtained.

For these arguments, and the rationale provided in the reply of June 22, 2005, it is submitted that pending claims 1, 2 and 4-7 are patentable over the proposed combination of the Mazur and Huang et al. patents. Accordingly, there is clear error in the rejection of claims 1, 2 and 4-7. Allowance of all of the pending claims is respectfully requested on a review of the aforementioned arguments and the reasons therefor.

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Date: November 10, 2005

Respectfully submitted,



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